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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No.: 10/072,429

Confirmation No.: 2615

In re Application of:

Jacques FAGOT et al.

On Appeal From:
Group Art Unit: 3711

Filed: February 7, 2002

Examiner: Stephen Luther Blau

For: SET OF GOLF CLUBS

REPLY BRIEF

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REPLY BRIEF

Appellants hereby file this Reply Brief pursuant to 37 C.F.R. § 41.41, to the Examiner's Answer mailed June 15, 2006.

I. FIRST READ THE CITED REFERENCES

The Examiner's Answer in this case, like the Office Actions during prosecution of the above-identified application, demonstrates the need for this Honorable Board to approach appellate review of the § 103(a) rejections herein in the order recommended by the U.S. Supreme Court in Graham v. John Deere Co., 383 U.S.1 (1966). In Deere, the Supreme Court said that § 103 analyses should initially pursue the factual inquiry into the scope and content of the prior art, before comparing an applicant or patentee's claimed invention to the prior art. This guards against hindsight assimilation of part or all of Applicants' claimed invention into the prior art—which appears to have occurred throughout the prosecution of this application, including in the Examiner's Answer.

Accordingly, Appellants recommend that this Honorable Board read the cited references, particularly the primary Peters and Besnard references, before considering Appellants' claims on appeal.

II. THE EXAMINER'S ANSWER ADMITS NUMEROUS MATERIAL VOIDS IN THE CITED PRIOR ART, AND STATES CONCLUSIONS NOT SUPPORTED BY THE CITED PRIOR ART

A. Peters '112

The final Office Action (3/28/05) expressly admitted, and now the Examiner's Answer (6/15/06, page 5) expressly admits that "Peters lacks":

[A] At least one recess in the upper wall and

[B] said at least one recess opens onto a rear face of an upper wall,

[C], the recess being elongated in a main direction of an upper wall,

[D] a volume of the recess being between .4 and 5% of the volume of the head, [see Appellants' claim 8]

[E] a volume of said at least one recess inside an upper wall varies from one iron to another within a set causing the center of gravity of each head to vary in distance relative to an upper face from one iron to another,

[F] the number of recesses decreases from long irons to short irons. [see Appellants' claim 12]

[G] the volume of recesses decreasing from long irons to short irons, [see Appellants' claim 11]

[H] and a set comprising at least three clubs. [see Appellants' claim 16]

That 3/28/05 Office Action, page 6, lines 66, 67, also admitted that "it is agreed that [P]eters does not disclosed an unfilled recess in any rear face." Indeed Peters does not disclose or suggest any rear face unfilled recess that is not filled with a weight, i.e., a material more dense than the material of which the remainder of the club head is formed.

Peters in no way suggests any special structure of the upper wall of each cavity-back, iron-type golf club head in a set, as claimed by Appellants. And Peters nowhere even remotely suggests changing the location of the center of gravity of club heads in a set of golf clubs by a specific configuration of the upper wall of cavity-back club heads. Peters does not discuss the volume of void recesses—particularly recesses in the upper wall. See again admissions [E], [F], and [G] above. Peters nowhere discloses or suggests varying the volume of a recess in a wall from one iron to another in a set of golf clubs, and Peters certainly makes no such disclosure or suggestion with respect to the upper wall of a cavity-back, iron-type golf club head.

Despite the above-admitted distinguishing voids and deficiencies in Peters, the Examiner's Answer, bridging pages 5 and 6, concludes:

It would have been obvious to modify the set of irons of Peters to have a volume of said at least one recess inside a lower wall varies from one iron to another within a set to cause a center of gravity of each head to vary in distance relative to an upper face of an upper wall from one iron to another and the number of recesses or volume changing from the long irons to short irons in order to have weights added more protected by being in an insert compared to being attached to a sole as shown in figure 3 of Peters.

No basis for this conclusion is stated in Peters or in the Examiner's Answer.

B. Besnard '112

Besnard (see Fig. 9) discloses an "upper perimeter portion of the peripheral belt [that] includes an elongated recess with a volume that . . . increases in the direction of the toe. Thus, . . . providing a gradual lightening of the upper portion of the peripheral edge towards the toe,...." (Besnard '112, col. 2, lines 27-36). Appellants' claimed invention does not involve such gradual lightening of the upper wall from heel to toe in a single club head.

Contrary to the conclusions stated in the Examiner's Answer, each of Peters, Besnard, and any combination thereof, lacks an entire set of like-type clubs, each having at least one

recess in its upper wall wherein the volume of the at least one recess varies from one iron to another within the set, as recited in Appellants' independent claim 1. See again admissions [G] and [H], above herein. And, two clubs (Peters Fig. 15, No. 158; or Figs. 20, 22) do not make up a set of three or more clubs (as in Appellants' claim 16).

The Examiner's Answer, page 6, also concludes, without cited basis:

In view of the patent of Besnard it would have been obvious to modify the set of irons of Peters to have at least one recess in the upper wall instead of the lower wall. . . .

This conclusion would modify Peters by deleting its key structure—weights in the lower wall—thereby destroying the disclosed Peters clubs. This conclusion uses hindsight, erroneously assimilating knowledge of Appellants' invention into the prior art.

After again admitting that Besnard does not disclose the subject matter of Appellants' dependent claim 8—that upper wall recess volume is between .4 and 5% of head volume—the Examiner's Answer, page 6, concludes:

Besnard does not specifically state the volume of the recesses. . . but. . . an artisan skilled. . . would have selected a suitable volume for the recesses in which a volume of the recess between .4 and 5 % of the volume of the head is included.

And, bridging pages 6 and 7 concludes:

In view of the patent of Besnard it would have been obvious to modify the set of irons of Peters to have a volume of the recess being between .4 and 5 % of the volume of the head. . . .

The Examiner's Answer admits that neither Peters nor Besnard discloses Appellants' claim 8 range. The Examiner's Answer, without basis, erroneously assimilates its subject matter into the prior art, another unsupported hindsight assumption.

Contrary to the Examiner's Answer, the cited references themselves demonstrate that there is no disclosure or teaching in either Peters or Besnard which suggests combining any specific portions of those references effectively to anticipate or suggest Appellants' claimed invention. Peters nowhere suggests specially configuring the upper wall of a cavity-back, iron-type golf club head. Peters also nowhere suggests gradually lightening from heel to toe either the upper or lower wall of such a club head. And Besnard nowhere suggests adding weight inserts to any portions of such a club head, particularly the upper wall thereof. Attempting to combine the structures of Peters and Besnard would necessarily destroy and render ineffective one or both of the reference disclosures, and would not have resulted in or rendered obvious Appellants' claimed invention.

C. Toulon

Finally, the citation, for the first time in the Examiner's Answer, pages 3 and 14, of Toulon U.S. Patent Application Publication No. 2002/0119828 is said, at, page 3, to be "prior art not relied upon" but is further stated to have been "cited as to develop what is known in the art by one skilled in the art." Toulon has not been identified as a basis for a new rejection. Yet, page 14, end of paragraph 17, of the Examiner's Answer expressly attempts to use Toulon to extrapolate the Besnard disclosure to subject matter that Besnard in fact does not disclose. Toulon discloses only wood-type golf clubs, and says nothing about perimeter weighted iron-type golf clubs such as those claimed by Appellants. Toulon adds nothing relevant to this record.

III. CONCLUSION

As again demonstrated above herein, despite the assumptions made in hindsight in the Examiner's Answer, the disclosures of the Peters and Besnard references, individually and collectively, are inadequate bases for rejection of Appellants' claims 1, 7, 8, 11, 12, 15 and 16. Accordingly, reversal of the stated rejections and allowance of all of those claims are respectfully requested.

Respectfully submitted,

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